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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/377,740	08/20/1999	KIMIKATSU SHOJI	32014-150502	8263

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EXAMINER

CRANE, SARA W

ART UNIT

PAPER NUMBER

2811

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/377,740

Applicant(s)

SHOJI ET AL.

Examiner

Sara W. Crane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-26 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19, 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Objection to the Specification - 35 U.S.C. 132

The amendment filed 12 February 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Each of the amendments to the specification referring to "common masks."

Each of the amendments changing "mask" to "masks."

Each of the amendments changing "layer" to "layers."

The specification as originally filed does not teach a "common" mask of any type, and in particular the specification does not teach a "common" mask for forming the gate array block and the plurality of functional blocks, as now recited in the claims. Each reference, in the specification as originally filed, of a mask used for formation of a non-customized layer, is in a discussion of the gate array block. There is no discussion of a mask used in common to form both the gate array block and the functional blocks. Also, changing the references (of "mask" and "layer") from singular to plural introduces new matter, because the teachings of the original specification did not refer to more than one mask or more than one layer.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-19 and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The step of "employing at least one common mask to form a plurality of functional blocks and a gate array block," as recited in the independent claims, is not taught in the specification as originally filed.

The steps of claims 25 and 26 also do not appear to be taught anywhere in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-19 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim terminology "common mask" is not clear. The remarks of 12 February 2003 (page 11, paragraph (b)) state that the word "common" does not mean that a

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single mask must be used to form the functional elements and the gate array block, but that the word "refers to the mask or masks used to form layers which are not customized." The word "common" does not mean "not customized." "Common" means "shared." No term may be given a meaning repugnant to the usual meaning of the term. MPEP 608.01(o).

Conclusion

Applicant's arguments with respect to the 132 objection and 112, first paragraph, rejections have been considered, but are not convincing. Applicant argues that the word "common" is to provide a name for the masks that are used to form the non-customized layer. No such mask is taught in the originally-filed specification. Applicant quotes from the amendment of 8 December 2000, but this was not part of the originally-filed specification. Applicant also states in the remarks that "one or more common masks are used to prepare the non-customized layer forming the CPU block 31, the peripheral blocks 32, the random logic blocks 33, and the gat array block 34." Again, however, this teaching is not in the specification as originally filed. The original specification does not say anything about "at least one mask . . . used to form the complete CPU block 31, peripheral blocks 32, random logic blocks 33, and the gate array block 34, the gate array block at this stage consisting of unconnected basic cells." The specification teaches the various blocks listed in the remarks, but doesn't say anything at all about the mask or masks used to form all the blocks as listed. Applicant

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needs to point out specific support, *in the specification as originally filed*, for each of the amendments noted above. Generalized discussion of the method, as Applicant now understands the method, is not sufficient, because this does not show that the originally-filed specification provides the necessary support.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Crane, whose telephone number is (703) 308-4894.

The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0956.



Sara W. Crane
Primary Examiner
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